

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, although the Examiner lists claim 35 as being rejected in the Summary section of the Official Action, no grounds of rejection is set forth therein. Applicant respectfully requests that the Examiner clarify the status of claim 35 in the next communication.

In the Official Action, the Examiner objects to claims 23 and 25 because the recitation of "flexible s wire" should be --flexible wire-- in claim 23 and "the as insertion" should be --the insertion-- in claim 25. In response, claims 23 and 25 have been amended as suggested by the Examiner. Although not objected to, claim 31 has been similarly amended as claim 25. Furthermore, claim 31 has also been amended to change "the distal end of the tube sheath" to --a distal end of the tube sheath--. Accordingly, it is respectfully requested that the objection to claims 23 and 25 be withdrawn.

In the Official Action, the Examiner rejects claims 29 and 30 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2002/0133178 to Muramatsu, et al., (hereinafter "Muramatsu"). Furthermore, the Examiner rejects claims 23, 24 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,766,184 to Matsuno, et al., (hereinafter "Matsuno") in view of Muramatsu. Still further, the Examiner rejects claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Matsuno and Muramatsu and further in view of U.S. Patent Application Publication No. 2004/0087985 to Loshakove (hereinafter "Loshakove"). Still further, the Examiner rejects claims 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Matsuno and Muramatsu and further in view of U.S. Patent No. 6,352,503 to Matsui (hereinafter "Matsui"). Still further, the

Examiner rejects claims 31, 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Muramatsu in view of Matsui. Lastly, the Examiner rejects claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Muramatsu in view of Loshakove.

In response, Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claims 23, 29 and 35 have been amended to clarify their distinguishing features. Specifically, claim 23 has been amended to recite (in clean copy for the convenience of the Examiner) a clip manipulating device comprising:

“a flexible insertion tube capable of being inserted into a cavity of a living body and having a curved portion at a distal end portion;

a flexible wire having pliability and movable through the insertion tube;

a junction provided on a distal end portion of the wire, detachably coupled with a clip located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip,

wherein the junction is pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, the junction is adapted to break when the wire is hauled with a tractive effort great enough to leave the clip and the junction includes a looped flexible wire of a predetermined length, one end of which is coupled with the clip and a coupling member connected to the flexible wire, the coupling member has a deformable portion coupling with the other end of the looped flexible wire, the deformable portion being deformable to release the looped flexible wire so that the junction is broken, and the looped flexible wire having a length between the clip and the deformable member such that when one end of the looped flexible wire engaged with the clip is released from the distal end portion of the flexible insertion tube, the coupling member does not enter the curved portion of the flexible insertion tube.”

Similarly, claim 29 has been amended to recite (in clean copy for the convenience of the Examiner) a clip manipulating device comprising:

“a flexible insertion tube capable of being inserted into a cavity of a living body and having a curved portion at a distal end portion;

a flexible wire having pliability and movably passed through the insertion tube;

a junction provided on a distal end portion of the wire, detachably coupled with a clip located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip,

wherein the junction is pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, the junction is adapted to break when the wire is hauled with a tractive effort great enough to leave the clip and the junction includes a looped flexible wire of a predetermined length, one end of which is coupled with the clip and a joint connected to the flexible wire, the joint being coupled with the other end of the looped flexible wire, said one end of the looped flexible wire being able to be broken to release the clip, and the looped flexible wire having a length between the clip and the joint such that when one end of the looped flexible wire engaged with the clip is released from the distal end portion of the flexible insertion tube, the joint does not enter the curved portion of the flexible insertion tube.”

Similarly, claim 35 has been amended to recite (in clean copy for the convenience of the Examiner) a clip manipulating device comprising:

“a flexible insertion tube capable of being inserted into a cavity of a living body and having a curved portion at a distal end portion;

a single flexible wire having pliability and movably passed through the insertion tube;

a junction provided on a distal end portion of the flexible wire, detachably coupled with a single clip located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip,

wherein the junction is pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, the junction is adapted to break when the flexible wire is hauled with a tractive effort great enough to leave the clip and the junction includes a looped flexible wire of a predetermined length, one end of which is coupled with the clip and a joint connected to the flexible wire, the joint being coupled with the other end of the looped flexible wire, said one end of the looped flexible wire being able to be broken to release the clip, and the looped flexible wire having a length

between the clip and the joint such that when one end of the looped flexible wire engaged with the clip is released from the distal end portion of the flexible insertion tube, the joint does not enter the curved portion of the flexible insertion tube.”

The amendments to claims 23, 29 and 35 are fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 23, 29 and 35. The dependent claims have also been amended and/or canceled, where necessary, to be consistent with their amended base claims.

With regard to the rejection of claims 29-30 based on Muramatsu, Applicant respectfully requests that the same be reconsidered based on the amendments to claim 29, as discussed above. Specifically, Muramatsu simply does not disclose or suggest “the looped flexible wire having a length between the clip and the joint such that when one end of the looped flexible wire engaged with the clip is released from the distal end portion of the flexible insertion tube, the joint does not enter the curved portion of the flexible insertion tube” as is not recited in claim 29.

With regard to the rejection of claims 23, 24 and 27 based on Matsuno, the Applicants respectfully submit that the Examiner has misinterpreted that which is disclosed by Matsuno. In the Official Action, the Examiner argues that the looped flexible wire corresponds to reference numeral 37 in Matsuno. However, Applicants submit that reference numeral 37 in Matsuno denotes a coupling plate, which is formed by punching stainless steel (column 5, lines 8-9). Thus, the coupling plate is not a deformable portion (e.g., hook 30) as is recited in claim 23. Therefore, Matsuno simply does not disclose or suggest “the coupling member has a deformable portion coupling with the other end of the looped flexible wire, the deformable portion being deformable to release the looped flexible wire so that the junction is broken” as is recited in claim 23.

Further with regard to Muramatsu, the J-shaped portion 3f cited by the Examiner is a part of the clip 3 as described in the paragraphs [0087] and [0093] of Muramatsu. The deformable (J-shaped) portion recited in the claims is not a part of the clip, and also will not be released from the flexible insertion tube during movement. The Examiner states a Muramatsu discloses a “junction pliable enough to follow substantial bending deformation.” However, Applicant can find no such disclosure in Muramatsu.

With regard to Matsui cited against claim 28, the same has been canceled and similar limitations incorporated into claims 23, 29 and 35. Figures 48-59 of Matsui indicated by the Examiner only disclose grasping forceps 205 being curved by a forceps raising base 201. Matsui does not disclose any positional relationship between the curved distal end of the grasping forceps 205 and the looped flexible wire as is now recited in claims 23, 29 and 35.

With regard to the rejection of claims 29 and 30 under 35 U.S.C. § 102(c), a clip manipulating device having the features discussed above and as recited in independent claim 29, is nowhere disclosed in Muramatsu. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 29 is not anticipated by Muramatsu. Accordingly, independent claim 29 patentably distinguishes over Muramatsu and is allowable. Claim 30 being dependent upon claim 29, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 29 and 30 under 35 U.S.C. § 102(a).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

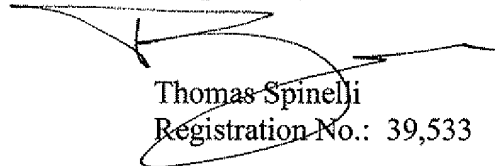
With regard to the rejection of claims 23, 24 and 27 under 35 U.S.C. § 103(a), independent claim 23 is not rendered obvious by the cited references because neither the Matsuno patent nor the Muramatsu patent, whether taken alone or in combination, teach or suggest a clip manipulating device having the features discussed above and recited in independent claim 23. Accordingly, claim 23 patentably distinguishes over the prior art and is allowable. Claims 24 and 27, being dependent upon claim 23, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 23, 24 and 27 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 25, 26, 28, 31, 32, 33 and 34 under 35 U.S.C. § 103(a), since independent claims 23 and 29 patentably distinguish over the prior art and are allowable, claims 25, 26, 31, 32 and 34 are at least allowable therewith because they depend from an allowable base claim (claims 28 and 33 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 25, 26, 28, 31, 32, 33 and 34 under 35 U.S.C. § 103(a).

Furthermore, new claims 36-39 have been added to further define the patentable invention. New claims 36-39 are fully supported in the original disclosure, for example at page 29, line 24 (“referring to the “rigid joint”) and the disclosure of the flexible looped wire throughout the specification. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 36-39. Applicant respectfully submits that new claim 36 is at least allowable as depending upon an allowable base claim (23). Applicants further submit that new independent claims 37-39 patentably distinguish over the prior art and are allowable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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